

THIS DISPOSITION IS NOT CITABLE  
AS PRECEDENT OF THE TTAB JULY 28, 99  
U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Borders Properties, Inc.

Books Beyond Borders, Inc.

Opposition No. 98,666  
to application Serial No. 74/578,500  
filed on **Sept. 26, 1994**

Samuel D. Littlepage of Dickinson Wright PLLC for Borders Properties, Inc.

Donald W. Margolis of Margolis & Associates for Books Beyond  
Borders, Inc.

Before Simms, Seeherman and Wendel, Administrative Trademark Judges.

Opinion by **Wendel**, Administrative Trademark Judge:

Books Beyond Borders, Inc. filed an application to register the mark BOOKS BEYOND BORDERS (stylized) for "printed matter, namely, non-fiction books on a variety of subject matters, including educational books; unmounted photographs; printed instructional, educational and teaching materials in the areas of relationships, psychology,

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metaphysics, parenting, multi-cultural studies, women's studies, education, and science; and playing cards."<sup>1</sup>

Borders Properties, Inc. filed an opposition to registration of the mark under Section 2(d) of the Trademark Act. Opposer alleges use since 1971 of the service mark and trademark BORDERS, in several formats, in connection with its retail "superstore" services, featuring the sale of books, and on various products, such as tote bags, coffee mugs, sweatshirts, hats and news bulletins; ownership of several registrations for these service marks and trademarks;<sup>2</sup> the acquisition of fame by its BORDERS mark in the field of book-related products and services; and the likelihood of confusion of applicant's mark BOOKS BEYOND BORDERS with opposer's mark or of an erroneous conclusion

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<sup>1</sup> Serial No. 74/578,500, filed Sept. 26, 1994, claiming a date of first use of Jan. 1993 and a date of first use in commerce of Feb. 1993.

<sup>2</sup>Reg. No. 1,187,210 for BORDERS BOOK SHOP for retail book store services, issued Jan. 19, 1982, Section 8 and 15;

Reg. No. 1,827,878 for BORDERS BOOKS & MUSIC for retail store services relating to books and music in various forms, issued Mar. 22, 1994;

Reg. No. 1,822,844 for BORDERS BOOK SHOP for apparel to be sold only through applicant's book and music retail stores and catalogs; namely, shirts, sweatshirts and hats, issued Feb. 22, 1994;

Reg. No. 1,788,121 for BORDERS BOOK SHOP for paper products, namely, shopping bags and news bulletins, issued Aug. 17, 1993;

Reg. No. 1,795,043 for BORDERS BOOK SHOP for coffee mugs, issued Sept. 28, 1993;

Reg. No. 1,790,407 for BORDERS BOOK SHOP for canvas tote bags, issued Aug. 31, 1993; and

Reg. No. 1,792,079 for BORDERS for retail store services relating to books and music in various forms, issued Sept. 7, 1993.

being made on the part of the public of sponsorship by opposer.

Applicant, in its answer, denied the salient allegations of the notice of opposition. As "affirmative defenses," applicant set forth various arguments with respect to the likelihood of confusion, including the difference between applicant's printed matter and opposer's book store services, the fact that opposer does not use the mark BOOKS BEYOND BORDERS, and opposer's failure to allege that its services are advertised in the same media as applicant's goods.<sup>3</sup>

#### The Record

The record consists of the file of the involved application; the trial testimony of opposer in the stipulated form of the affidavit of Marilyn Slankard; and opposer's three notices of reliance introducing status and title copies of its registrations,<sup>4</sup> copies of sixty-eight

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<sup>3</sup> Although labeled as "affirmative defenses", these allegations relate only to opposer's claim of likelihood of confusion. Although applicant did set forth the true affirmative defense of laches, this claim was stricken from the answer as a result of the Board's decision of April 25, 1997 on opposer's motion for summary judgment.

<sup>4</sup> In its notice of reliance, opposer has included copies of four additional registrations that issued since the filing of the notice of opposition, namely:

Reg. No. 1,939,505 for BORDERS BOOKS AND MUSIC for retail store services relating to books and music in various forms, issued Dec. 5, 1995;

Reg. No. 1,996,540 for BORDERS CAFÉ ESPRESSO for restaurant services in retail book and music stores, issued Aug. 27, 1996;

third-party registrations, and applicant's answers to opposer's Interrogatory Nos. 1, 3, 10, 16, 22 and 23.<sup>5</sup> Applicant took no testimony and has no evidence of record. Only opposer filed a brief and an oral hearing was not requested.

Marilyn Slankard, the Vice-President of Marketing for Borders, Inc., states in her affidavit that Borders, Inc.<sup>6</sup> is the premier operator of book "superstores" in the United

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Reg. No. 2,011,801 for FIND OUT/BORDERS for retail store services featuring books, magazines, CD-ROMs, and music in various forms, issued Oct. 29, 1996;  
and

Reg. No. 2,044,230 for BORDERS for computerized on-line retail services in the field of books, magazines, music, pre-recorded video cassettes, and CD-ROMs, issued Mar. 11, 1997.

While the notice of opposition was not amended to plead these additional registrations, since applicant has raised no objections thereto, the pleadings are deemed so amended pursuant to FRCP 15(b).

<sup>5</sup> In response to opposer's third notice of reliance, applicant filed a notice of reliance upon a complete set of applicant's responses to opposer's interrogatories, stating that the complete answers should be considered "so as to make not misleading the partial answers which were offered by Opposer."

Opposer then filed, on December 23, 1997, a motion to strike this notice of reliance, arguing that applicant had not complied with the requirements of Rule 2.120(j)(5), in that applicant had merely submitted all of its answers and had not explained why they should be considered, which answers being relied upon by opposer needed to be clarified or which other specific answers would serve this purpose.

The Board, in its action of January 21, 1998, deferred decision on the motion until filing hearing.

No response was ever filed by applicant to the motion. Accordingly, and since the motion appears to be well-taken, the motion is granted. Applicant's notice of reliance is stricken from the record. Moreover, even if this evidence had been considered on applicant's behalf, it would not have changed the result.

<sup>6</sup> Borders, Inc. is the parent company and the licensee of the marks in the registrations owned by opposer.

States and operates 184 superstores in 36 states and the District of Columbia;<sup>7</sup> that each superstore offers a wide assortment of books, carrying an average of 128,000 different book titles; that each superstore offers special order service for customers to obtain books not in stock or not in the inventory of any BORDERS store; that, besides fiction books, BORDERS stores sell non-fiction books, educational books and materials, unmounted photographs and cards; that total sales for BORDERS stores since 1993 have been in excess of \$3 billion and have involved the sale of at least 180 million books; that advertising expenditures over the last five years have been over \$47 million; and that Borders, Inc., in promoting its name and services, relies upon a diverse marketing strategy, including print advertising, radio and television advertising, catalogs, newsletters, store events, such as author signings, children's storytelling, and events tailored to the interests of a specific community, and a web site on the Internet. Numerous samples of these promotional activities and materials have been submitted as exhibits to the affidavit.

The Opposition

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<sup>7</sup> The affidavit was executed in October 1997.

Priority is not an issue here, in view of opposer's submission of status and title copies of its registrations proving ownership of valid and subsisting registrations for its BORDERS mark in a variety of forms. King Candy Co., Inc., v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Thus, we turn to the issue of likelihood of confusion and to the du Pont factors which are most relevant to the circumstances at hand. See In re du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

We look first to the similarity or dissimilarity of the books and other printed materials of applicant and the book store services of opposer. Opposer points to the statement in the Slankard affidavit that goods identical to those named in applicant's application are sold in opposer's book stores. Opposer also relies upon the third-party registrations which it has made of record showing that books and other printed materials and the retail store services connected with the sale of these goods are often offered to the public by one particular entity under a single mark. On the basis of this evidence, opposer argues that there is a close relationship between applicant's goods and opposer's book store services.

We agree. The third-party registrations are adequate to establish that goods and services similar to those

involved here are frequently marketed under the same mark by a single source, and thus purchasers are likely to assume a common source for the two. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); and *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ3d 1467 (TTAB 1988). We also have evidence that opposer itself sells products identical to each and every of applicant's goods, albeit under marks different from opposer's BORDERS marks. Furthermore, opposer has made of record applicant's responses to opposer's Interrogatory Nos. 16, 22 and 23, indicating that applicant has in fact sold its books in certain of opposer's stores. Thus, we find that there is a close relationship between the goods of applicant and the book store services of opposer.

As a corollary, there is necessarily a high degree of similarity of the channels of trade for applicant's books and opposer's retail store services. As pointed out by opposer, applicant has placed no restrictions on the channels of trade for its goods in its application and thus they must be presumed to travel in all the normal channels of trade for goods of this nature. See *Kangol Ltd. v. KangaROOS U.S.A.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992) and the cases cited therein. Moreover, in its response to Interrogatory No. 10, applicant states that it sells its products to "book distributors, book wholesalers

and book retailers," as well as to non-profit groups, special interest groups, educational institutions and the like. Thus, it is highly likely that applicant's books and other printed materials would be sold in book stores such as opposer's. Not only are the channels of trade similar, but there also are no distinctions which can be drawn with respect to the type of purchasers for applicant's goods.

Of great significance in this case is the fame of opposer's BORDERS mark. In view of the sales and advertising figures and the extensive promotional materials made of record by opposer, as well as the failure of applicant to contest the matter, we find the fame and renown of opposer's BORDERS mark, in its various formats, to be without question. Thus, we must be guided by the principle set forth by our chief reviewing court in *Kenner Parker Toys Inc. v. Rose Art Industries Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992) that the "Lanham Act's tolerance for similarity between competing marks varies inversely with the fame of the prior mark." See also *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

And so it is on this basis that we consider the similarity or dissimilarity of the marks. Opposer argues that the dominant portion of both opposer's BORDERS marks and applicant's mark BOOKS BEYOND BORDERS is the word

"Borders" and that applicant has simply incorporated the dominant portion of opposer's marks into its mark and added the descriptive modifying words "Books Beyond." By this addition, opposer argues, the public will be led to believe that BOOKS BEYOND BORDERS is being used as a new variation of opposer's marks, to indicate books that may be obtained outside of or "beyond" opposer's normal channels of distribution. Opposer contends that applicant's mark sends out a false message of association or sponsorship of applicant's products by opposer. Opposer likens the situation to that in *Blue Cross and Blue Shield Association v. Harvard Community Health Plan Inc.*, 17 USPQ2d 1075 (TTAB 1990), wherein the applicant's mark THE CURE FOR THE BLUES was found to be likely to cause consumers to believe that the applicant's health care services were sponsored by, or somehow associated with, the opposer and its BLUE CROSS, BLUE SHIELD and other BLUE marks.

Applicant, on the other hand, has neither taken any testimony nor properly presented any other evidence in rebuttal to opposer's case. We are without any evidence as to any meaning which applicant may attribute to its mark or as to the commercial impression intended to be projected by the mark when used with applicant's publications.<sup>8</sup>

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<sup>8</sup> Applicant presented arguments with respect to the connotation of its mark in response to opposer's motion for summary judgment, and as a result, genuine issues as to commercial impressions of

Accordingly, given the fame of opposer's BORDERS mark and the close relationship between applicant's books and the book store services of opposer, we are led to the conclusion that potential purchasers of applicant's books published under the BOOKS BEYOND BORDERS mark would be likely to assume that the books are sponsored by, or in some way associated with, opposer. Even though applicant's mark is arguably a unitary phrase, we believe the presence of the word BORDERS, as it is used in the mark, would be viewed by purchasers as a reference to opposer and its well-known bookstores. As in the *Blue Cross/Blue Shield* case, we have both the presence of a word highly likely to be viewed as a reference to opposer in applicant's mark and a close relationship between the goods and/or services of the parties. Faced with this combination, we find confusion on the part of the purchasing public likely.

There is the additional du Pont factor of lack of actual confusion which is relevant here. Opposer concedes that it is unaware of any instances of actual confusion, even with the sale of applicant's books in opposer's stores. We must agree with opposer, however, that although this

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the marks were found to exist. These arguments, however, and more particularly, any evidence relied upon by applicant in response to the motion for summary judgment are not part of the evidentiary record before us at final hearing, not having been introduced into evidence during applicant's testimony period. See TBMP § 528.05(a).

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factor may appear to favor applicant, this does not preclude a finding of likelihood of confusion. Furthermore, there is the possibility that purchasers might simply assume there is a connection between applicant's books and opposer and make no inquiries as to the source of the books. See *Tiffany & Co. v. Classic Motor Carriages Inc.*, 10 USPQ2d 1835 (TTAB 1989).

Decision: The opposition is sustained and registration is refused to applicant.

R. L. Simms

E. J. Seehermann

H. R. Wendel  
Trademark Administrative Judges,  
Trademark Trial and Appeal Board